

**REMARKS**

Applicant respectfully requests reconsideration of the present case in view of the above amendments and the following remarks.

Claims 1, 4-5, and 11-13 are currently pending, and claims 5, 11 and 12 have been withdrawn. Claims 2, 3 and 6-10 have been cancelled, and claim 13 has been added. No new matter has been inserted. Support for new claim 13 can be found in claims 3 and 8 and throughout the specification.

**35 U.S.C. § 112**

Claims 3 and 8 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant respectfully traverses this rejection.

In the interest of advancing prosecution, claims 3 and 8 have been cancelled rendering this rejection moot. Applicant respectfully requests that this rejection be withdrawn.

**Claim Objections**

Claims 6-8 were objected to because of informalities, and claim 7 was objected to as being a substantial duplicate of claim 1. In response, claims 6-8 have been cancelled rendering these objections moot. Applicant respectfully requests that these objections be withdrawn.

**35 U.S.C. § 103(a)**

Claims 1-4 and 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 360196185A in view of Gottlieb. Applicant respectfully traverses this rejection.

JP 360196185A discloses a semi-synthetic culture medium for yeast. However, as conceded by the Examiner JP 360196185A fails to disclose a culture medium comprising "between about 4.5 g/l and about 5.5 g/l of monobasic potassium phosphate" as required by claim 1.

Gottlieb fails to cure the deficiencies of JP 360196185A. Gottlieb discloses an assay medium having 1 gram of monobasic potassium phosphate in a volume of 1 liter. However, Gottlieb fails to disclose or suggest a culture medium comprising "between about 4.5 g/l and about 5.5 g/l of monobasic potassium phosphate" as required by claim 1. Therefore, the combination of JP 360196185A and Gottlieb fails to teach or suggest the invention of claim 1.

In addition, JP 360196185A discloses magnesium sulfate but fails to disclose or suggest "between about 0.5 g/l and about 1.5 g/l of heptahydrate magnesium sulfate" as required by claim 1 (emphasis added). Applicant points out that magnesium sulfate (CAS Reg. # 7487-88-9) and heptahydrate magnesium sulfate (CAS Reg. # 10034-99-8) are different compounds.

Again, Gottlieb fails to cure the deficiencies of JP 360196185A. Gottlieb fails to disclose or suggest "between about 0.5 g/l and about 1.5 g/l of heptahydrate magnesium sulfate" as required by claim 1. Therefore, at least for this additional reason, the combination of JP 360196185A and Gottlieb fails to teach or suggest the invention of claim 1.

Furthermore, Applicant asserts that the Examiner has failed to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness requires some suggestion or motivation to combine the references. See MPEP § 2143. In this case, Applicant asserts that there is no motivation to combine JP 360196185A with Gottlieb to result in the invention as claimed.

The Examiner alleges that "one of skill in the art would have been motivated to combine these disclosed ingredients together in a culture medium because they are taught to be used for culturing yeast." However, Applicant points out that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." See MPEP §2143.01; *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, there is nothing in either reference to suggest the desirability of taking monobasic potassium phosphate from Gottlieb and adding it to the components of JP 360196185A. Further, there is nothing in either reference to suggest the desirability of "between about 4.5 g/l and about 5.5 g/l of monobasic potassium phosphate" as required by claim 1.

For at least these reasons, the combination of JP 360196185A with Gottlieb fails to render claim 1 obvious. As claim 4 is dependent on claim 1, it is also not rendered obvious. As

claims, 2-3 and 6-10 have been cancelled, this rejection is moot as applied to them. Applicant respectfully requests that this rejection be withdrawn.

Summary

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

29 July 2005  
Date



Brian H. Batzli  
Reg. No. 32,960  
Merchant & Gould P.C.  
P. O. Box 2903  
Minneapolis, MN 55402-0903  
612.336.4755

BHB:MED:kf

